



DEPARTMENT OF COMMERCE

[3510-16]

United States Patent and Trademark Office

37 CFR Parts 2, 6, and 7

[Docket No. PTO-T-2013-0026]

RIN 0651-AC88

Miscellaneous Changes to Trademark Rules of Practice and the Rules of Practice in Filings Pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks

AGENCY: United States Patent and Trademark Office, Commerce

ACTIONS: Notice of Proposed Rulemaking

SUMMARY: The United States Patent and Trademark Office (“Office”) proposes to amend the Trademark Rules of Practice and the Rules of Practice in Filings Pursuant to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks to benefit the public by providing greater clarity as to certain requirements relating to representation before the Office, applications for registration, examination procedures, amendment of applications, publication and post publication procedures, appeals, petitions, post registration practice, correspondence in trademark cases, classification of goods and services, and procedures under the Madrid Protocol. For the most part, the proposed rule changes are intended to codify existing practice.

DATES: Comments must be received by [INSERT DATE 90 DAYS FROM THE DATE OF PUBLICATION IN THE FEDERAL REGISTER] to ensure consideration.

ADDRESSES: The Office prefers that comments be submitted via electronic mail message to TMFRNotices@uspto.gov. Written comments also may be submitted by mail to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, attention Cynthia C. Lynch; by hand delivery to the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, Virginia, attention Cynthia C. Lynch; or by electronic mail message via the Federal eRulemaking Portal. See the Federal eRulemaking Portal Web site (<http://www.regulations.gov>) for additional instructions on providing comments via the Federal eRulemaking Portal. Written comments will be available for public inspection on the Office's Web site at <http://www.uspto.gov>, on the Federal eRulemaking Portal, and at the Office of the Commissioner for Trademarks, Madison East, Tenth Floor, 600 Dulany Street, Alexandria, Virginia.

FOR FURTHER INFORMATION CONTACT: Cynthia C. Lynch, Office of the Deputy Commissioner for Trademark Examination Policy, by email at TMPolicy@uspto.gov, or by telephone at (571) 272-8742.

SUPPLEMENTARY INFORMATION

Executive Summary: Purpose: The proposed rules will benefit the public by providing more comprehensive and specific guidance regarding certain requirements relating to representation before the Office, applications for registration, examination procedures, amendment of applications, publication and post publication procedures, appeals,

petitions, post registration practice, correspondence in trademark cases, classification of goods and services, and procedures under the Madrid Protocol. For the most part, the proposed rule changes are intended to codify existing practice.

Summary of Major Provisions: As stated above, the Office proposes to revise the rules in parts 2, 6, and 7 of title 37 of the Code of Federal Regulations to codify current Office practice and provide sufficient detail regarding miscellaneous requirements relating to representation before the Office, applications for registration, examination procedures, amendment of applications, publication and post publication procedures, appeals, petitions, post registration practice, correspondence in trademark cases, classification of goods and services, and procedures under the Madrid Protocol.

Costs and Benefits: This rulemaking is not economically significant under Executive Order 12866 (Sept. 30, 1993).

References below to “the Act,” “the Trademark Act,” or “the statute” refer to the Trademark Act of 1946, 15 U.S.C. 1051 et seq., as amended. References to “TMEP” or “Trademark Manual of Examining Procedure” refer to the October 2013 edition.

Discussion of Proposed Rules Changes

Representation by Attorneys or Other Authorized Persons

The Office proposes to revise § 2.17(d)(1) to remove the reference to the number of powers of attorney that can be filed via the Trademark Electronic Application System (“TEAS”) for existing applications or registrations that have the identical owner and attorney. The TEAS Revocation of Attorney/Domestic Representative and/or

Appointment of Attorney/Domestic Representative form currently indicates that up to 300 applications or registrations may be amended per request. The proposed revision is intended to remove outdated information, and will allow more flexibility for future enhancements to TEAS.

The Office proposes to revise § 2.19(b) to require compliance with § 11.116, rather than § 10.40, as part 10 of this chapter has been removed and reserved (78 FR 20180 (April 3, 2013)) and § 11.116 now sets out the requirements for terminating representation.

Applications for Registration

The Office proposes to revise § 2.22(a)(19) to indicate that if a TEAS Plus applicant owns one or more registrations for the same mark shown in the application, and the last listed owner of the prior registration(s) differs from the owner of the application, the application must include a claim of ownership for the prior registration(s) in order to be entitled to the reduced filing fee under § 2.6(a)(1)(iii). This limits the circumstances under which a TEAS Plus applicant is required to claim ownership of a prior registration and is consistent with the proposed revision to the claim of ownership requirements in § 2.36.

The Office proposes to revise § 2.36 to indicate that an applicant is only required to claim ownership of prior registrations for the same or similar marks if the owner listed in the application differs from the owner last listed in the Office's database for such prior registrations. This is consistent with existing practice.

The Office proposes to revise § 2.38(b) to remove the requirement that an application indicate that, if the applied-for mark is not being used by the applicant but is being used by one or more related companies whose use inures to the benefit of the applicant under section 5 of the Act, such fact must be indicated in the application.

The Office further proposes to redesignate § 2.38(c) as § 2.38(b), as the requirement in current § 2.38(b) is being removed.

Examination of Application and Action by Applicants

The Office proposes to add new § 2.62(c) to specify that responses to Office actions must be filed through TEAS, transmitted by facsimile, mailed, or delivered by hand, and that responses sent by e-mail will not be accorded a date of receipt. This is consistent with existing practice.

The Office proposes to amend the title of § 2.63 from “Reexamination” to “Action after response,” as revised § 2.63 incorporates a discussion of reexamination, the filing of petitions and appeals, and abandonments.

The Office proposes to revise § 2.63(a) to clarify that after submission of a response by the applicant, the examining attorney will review all statutory refusal(s) and/or requirement(s) in light of the response. This is consistent with TMEP section 713.

The Office proposes to add § 2.63(a)(1) to clarify that the applicant may respond to a non-final action that maintains any requirement(s) or substantive refusal(s) by filing a timely response to the examiner’s action. This is consistent with TMEP section 713.

The Office proposes to add § 2.63(a)(2) to clarify that the applicant may respond to a non-final action that maintains any requirement(s) by filing a petition to the Director under § 2.146 if the subject matter of the requirement(s) is appropriate for petition, that if the petition is denied, the applicant will have six months from the date of the Office action which repeated the requirement(s), or thirty days from the date of the decision on the petition, whichever is later, to comply with the repeated requirement(s), and that a requirement which is the subject of a petition to the Director subsequently may not be the subject of an appeal to the Trademark Trial and Appeal Board (“TTAB”). This is consistent with TMEP sections 713 and 1702.

The Office proposes to revise § 2.63(b) to clarify that the examining attorney may make final a refusal or a requirement upon review of a response or request for reconsideration. This is consistent with current § 2.64(a) and TMEP sections 713 and 714.03.

The Office proposes to add § 2.63(b)(1) to clarify that the applicant may respond to a final action that maintains any substantive refusal(s) under sections 2, 3, 4, 5, 6, or 23 of the Act by filing an appeal to the TTAB under §§ 2.141 and 2.142. This is consistent with TMEP section 1501.01.

The Office proposes to add § 2.63(b)(2) to clarify that the applicant may respond to a final action that withdraws all substantive refusals but maintains any requirement(s) either by filing an appeal to the TTAB under §§ 2.141 and 2.142, or by filing a petition to the Director under § 2.146, if the subject matter of the requirement(s) is procedural, and

therefore appropriate for petition. This is consistent with current § 2.63(b) and TMEP sections 1501.01 and 1704.

The Office proposes to add § 2.63(b)(3) to clarify that the applicant may file a request for reconsideration of the final action prior to the expiration of the time for filing an appeal to the TTAB or a petition to the Director, that the request must be signed by a party authorized under § 2.193(e)(2), and that the request does not stay or extend the time for filing an appeal or petition. This is consistent with current § 2.64(b) and TMEP section 715.03.

The Office proposes to add § 2.63(b)(4) to clarify that the filing of a request for reconsideration that does not result in the withdrawal of all refusals and requirements, without the filing of a timely appeal or petition, will result in abandonment of the application for incomplete response. This is consistent with section 12(b) of the Act and current § 2.65(a).

The Office proposes to add § 2.63(c) to clarify both that if a petition to the Director under § 2.146 is denied, the applicant will have until six months from the date of issuance of the Office action that repeated the requirement(s), or made it final, or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement(s), and that a requirement that is the subject of a petition decided by the Director subsequently may not be the subject of an appeal to the TTAB. This is consistent with current § 2.63(b) and TMEP section 1702.

The Office proposes to add § 2.63(d) to clarify that if an amendment to allege use is filed during the six-month response period after issuance of a final action, the

examining attorney will examine the amendment, but the filing of the amendment does not stay or extend the time for filing an appeal to the TTAB or a petition to the Director. This is consistent with current § 2.64(c)(1) and TMEP sections 711 and 1104.

The Office proposes to remove and reserve § 2.64 and incorporate updated final action procedures into proposed revised § 2.63.

The Office proposes to revise § 2.65(a) both to clarify that an application will be deemed abandoned if an applicant fails to respond, or respond completely, to an Office action within six months of the issuance date, but a timely petition to the Director or notice of appeal to the TTAB, if appropriate, is considered to be a response that avoids abandonment, and to revise the reference to § 2.63(b) so as to reference § 2.63(a) and (b). The clarification is consistent with TMEP section 718.03 and the revision to the reference accounts for the proposed amendment to § 2.63 which sets out the conditions for a petition under § 2.146 in § 2.63(a) and (b) instead of only § 2.63(b).

The Office proposes to add § 2.65(a)(1) to clarify that if an applicant fails to timely respond to an Office action, but all refusals or requirements are expressly limited to certain goods or services, the application will be abandoned only as to those goods or services. This is consistent with current § 2.65(a) and TMEP section 718.02(a).

The Office proposes to add § 2.65(a)(2) to clarify that an applicant may, in certain situations, be granted thirty days, or to the end of the response period set forth in the action, whichever is longer, to provide information omitted from a response before the examining attorney considers the issue of abandonment. This is consistent with current § 2.65(b) and TMEP section 718.03(b).

The Office proposes to revise § 2.65(b) to clarify that an application will be abandoned if an applicant expressly abandons the application pursuant to § 2.68. This is consistent with TMEP section 718.01.

The Office proposes to revise § 2.65(c) to clarify that an application under section 1(b) of the Act will be abandoned if the applicant fails to file a timely statement of use under § 2.88 or a request for an extension of time for filing a statement of use under § 2.89. This is consistent with section 1(d)(4) of the Act and TMEP sections 1108.01 and 1109.04.

The Office proposes to revise § 2.68(a) to indicate that a request for abandonment or withdrawal may not subsequently be withdrawn. This is consistent with TMEP section 718.01, and is intended to provide applicants, registration owners, and the public assurance of the accuracy of the status of applications or registrations after filings are received by the Office.

The Office proposes to revise § 2.68(b) for clarity by moving the “in any proceeding before the Office” clause to the end of the sentence.

Amendment of Application

The Office proposes to revise § 2.77(b) to indicate that amendments not listed in § 2.77(a) may be entered in the application in the time period between issuance of the notice of allowance and submission of a statement of use only with the express permission of the Director, after consideration on petition under § 2.146. This is consistent with TMEP sections 1107 and 1505.01(d), which currently require a waiver of § 2.77 on petition.

Publication and Post Publication

The Office proposes to revise § 2.81(b) to remove the list of items that will be included on the notice of allowance. The proposed change allows greater flexibility in the format of notices of allowance, to allow for changes that may occur in conjunction with the Office's "Trademarks Next Generation" information technology initiative. As a matter of practice, at this time, the Office plans to continue to maintain the current format of the notice of allowance.

The Office proposes to revise § 2.84(b) to clarify that an application that is not the subject of an inter partes proceeding before the TTAB may be amended after the mark has been published for opposition, but before the certificate of registration has been issued under section 1(a), 44, or 66(a) of the Act, or before the notice of allowance has been issued in an application under section 1(b) of the Act, if the amendment meets the requirements of §§ 2.71, 2.72, and 2.74. This is consistent with existing practice.

Appeals

The Office proposes to revise § 2.142(f)(3) and (f)(6) to remove the references to § 2.64, as the Office is proposing to remove and reserve § 2.64, with the sections of § 2.64 relevant to § 2.142(f)(3) and (f)(6) incorporated into proposed revised § 2.63.

The Office proposes to revise § 2.145(a) to add registrants who have filed an affidavit or declaration under section 71 of the Act and are dissatisfied with a decision of the Director to the list of parties eligible to appeal to the U.S. Court of Appeals for the Federal Circuit. This is consistent with TMEP section 1613.18(d).

The Office proposes to revise § 2.146(a)(1) and (g) to replace references to § 2.63(b) with references to § 2.63(a) and (b), as the Office is proposing to list conditions for a petition under § 2.146 in § 2.63(a) and (b) instead of only § 2.63(b).

Post Registration

The Office proposes to revise § 2.172 to clarify that a surrender for cancellation may not subsequently be withdrawn. This is consistent with existing practice.

The Office proposes to revise § 2.185(a) to indicate that deficiencies in renewal applications may be corrected after notification from the Office. This is consistent with existing practice.

General Information and Correspondence in Trademark Cases

The Office proposes to amend § 2.198(a)(1) by adding § 2.198(a)(1)(viii) to include affidavits under section 71 of the Act in the list of documents excluded from the Office's Express Mail procedure. This is consistent with the handling of corresponding affidavits under section 8 of the Act. In connection with this addition, the Office proposes to revise § 2.198(a)(1)(vi) and § 2.198(a)(1)(vii) for clarity.

Classification of Goods and Services

The Office proposes to revise § 6.1(5) to add the wording "or veterinary" to the entry "dietetic food and substances adapted for medical use" in the listing of goods for International Class 5. This is consistent with the current heading for the international class as established by the Committee of Experts of the Nice Union and set forth in the International Classification of Goods and Services for the Purposes of the Registration of

Marks published annually by the World Intellectual Property Organization (“WIPO”) on its web site.

Madrid Protocol

The Office proposes to revise § 7.11(a)(3)(ii) to clarify that if the mark in the basic application or registration is depicted in black-and-white and includes a color claim, an international application filed on paper must include both black-and-white and color reproductions of the mark, and an international application filed electronically must include a color reproduction of the mark. This is consistent with existing practice as the WIPO paper application form requires the applicant to submit both black-and-white and color reproductions of the mark, while the Office’s electronic application form requires only that the applicant submit a color reproduction of the mark.

The Office proposes to revise § 7.23(a)(5) to require that a request to record an assignment of an international registration submitted through the Office include a statement that, after making a good faith effort, the assignee could not obtain the assignor’s signature for the request to record the assignment and be signed and verified or supported by declaration under § 2.20. This revision is intended to ensure that assignees make a good-faith effort to obtain the assignor’s signature before invoking this rule and requesting the Office to forward the assignment document to the International Bureau (“IB”) of WIPO.

The Office proposes to revise § 7.23(a)(6) to indicate that a request to record an assignment of an international registration submitted through the Office must include an indication that the assignment applies to the designation to the United States or an

international registration that was originally based on a United States application or registration. This revision is intended to ensure that an assignee of an international registration based on a U.S. registration or application is treated the same as an assignee of a designation to the U.S. Current practice is that the owner of the international registration based on a U.S. registration or application must file a petition to waive this subsection of the rule.

The Office proposes to revise § 7.24(b)(5)(ii) to require that a request, submitted through the Office, to record a restriction, or the release of a restriction, that is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal must include a statement indicating that, after making a good faith effort, the signature of the holder of the international registration could not be obtained for the request to record the restriction, or release of the restriction, and be signed and verified or supported by declaration under § 2.20. This revision is intended to ensure that assignees make a good faith effort to obtain the assignor's signature before invoking this rule and requesting the Office to forward the document to the IB.

The Office proposes to revise § 7.24(b)(7) to indicate that a request to record a restriction, or the release of a restriction, must include an indication that the restriction, or the release of the restriction, of the holder's right of disposal of the international registration applies to the designation to the United States or an international registration that was originally based on a United States application or registration. This revision is intended to ensure that an assignee of an international registration based on a U.S. registration or application is treated the same as an assignee of a designation to the U.S.

Current practice is that the owner of the international registration based on a U.S. registration or application must file a petition to waive this subsection of the rule.

The Office proposes to revise § 7.25(a) to add §§ 2.21, 2.76, 2.88, and 2.89 to the list of sections in part 2 not applicable to an extension of protection. This is consistent with existing practice as the section relates to procedures only applicable to applications under sections 1 or 44 of the Act.

The Office proposes to amend § 7.31 by revising the introductory text and § 7.31(a)(3) to require that a request to transform an extension of protection to the United States into a U.S. application specify the goods and/or services to be transformed. This revision is intended to ensure that the Office transforms an accurate listing of goods and/or services.

The Office further proposes to redesignate current § 7.31(a)(3) as § 7.31(a)(4) and current § 7.31(a)(4) as new § 7.31(a)(5) because current § 7.31(a)(3) is being revised to require that a request to transform an extension of protection to the United States into a U.S. application specify the goods and/or services to be transformed.

Rulemaking Considerations

Administrative Procedure Act: The changes proposed in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See Nat'l Org. of Veterans' Advocates v. Sec'y of Veterans Affairs, 260 F.3d 1365, 1375 (Fed. Cir. 2001) (rule that clarifies interpretation of a statute is interpretive); Bachow Commc'ns Inc. v. FCC, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); Inova Alexandria Hosp. v. Shalala,

244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims).

Accordingly, prior notice and opportunity for public comment for the proposed rule changes are not required pursuant to 5 U.S.C. 553(b) or (c), or any other law. See Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336-37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice,” quoting 5 U.S.C. 553(b)(A)). However, the Office has chosen to seek public comment before implementing the rule.

Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a Regulatory Flexibility Act analysis, nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), is required. See 5 U.S.C. 603.

In addition, for the reasons set forth herein, the Deputy General Counsel for General Law of the United States Patent and Trademark Office has certified to the Chief Counsel for Advocacy of the Small Business Administration that rule changes proposed in this notice will not have a significant economic impact on a substantial number of small entities. See 5 U.S.C. 605(b). This notice proposes changes to rules of agency practice and procedure. The primary impact of the proposed rule changes is to provide greater clarity as to certain requirements relating to representation before the Office, applications for registration, examination procedures, amendment of applications, publication and post publication procedures, appeals, petitions, post registration practice,

correspondence in trademark cases, classification of goods and services, and procedures under the Madrid Protocol. For the most part, the proposed rule changes are intended to codify existing practice. The burdens, if any, to all entities, including small entities, imposed by these proposed rule changes would be minor. Additionally, in a number of instances, the proposed rule changes would lessen the burdens on applicants. Therefore, the proposed rule changes will not have a significant economic impact on a substantial number of small entities.

Executive Order 12866: The proposed rulemaking has been determined to be not significant for purposes of Executive Order 12866.

Executive Order 13563 (Improving Regulation and Regulatory Review): The Office has complied with Executive Order 13563 (Jan. 18, 2011). Specifically, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the proposed rule changes; (2) tailored the proposed rules to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) provided the public with a meaningful opportunity to participate in the regulatory process, including soliciting the views of those likely affected prior to issuing a notice of proposed rulemaking, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes, to the extent applicable.

Executive Order 13132: The proposed rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the Office will submit a report containing the final rule and other required information to the U.S. Senate, the U.S. House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this proposed rulemaking are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this notice is not expected to result in a “major rule” as defined in 5 U.S.C. 804(2).

Unfunded Mandate Reform Act of 1995: The Unfunded Mandates Reform Act (2 U.S.C. 1501 et seq.) requires that agencies prepare an assessment of anticipated costs and benefits before issuing any rule that may result in expenditure by State, local, and tribal governments, in the aggregate, or by the private sector, of \$100 million or more (adjusted annually for inflation) in any given year. This proposed rulemaking would have no such effect on State, local, and tribal governments or the private sector.

Paperwork Reduction Act: This proposed rulemaking involves information collection requirements which are subject to review by the U.S. Office of Management

and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.).

The Office has determined that there would be no new information collection requirements or impacts to existing information collection requirements associated with this proposed rulemaking. The collections of information involved in this proposed rulemaking have been reviewed and previously approved by OMB under control numbers 0651-0009, 0651-0050, 0651-0051, 0651-0054, 0651-0055, 0651-0056, and 0651-0061.

The Office is soliciting comments to: (1) evaluate whether the proposed collection of information is necessary for the proper performance of the functions of the agency, including whether the information will have practical utility; (2) evaluate the accuracy of the agency's estimate of the burden of the proposed collection of information, including the validity of the methodology and assumptions used; (3) enhance the quality, utility, and clarity of the information to be collected; and (4) minimize the burden of information on those who are to respond, including through the use of appropriate automated, electronic, mechanical, or other technological collection techniques or other forms of information technology, e.g., permitting electronic submission of responses.

Interested persons are requested to send comments regarding this information collection by [INSERT DATE 90 DAYS AFTER DATE OF PUBLICATION IN THE FEDERAL REGISTER], to: (1) The Office of Information and Regulatory Affairs, Office of Management and Budget, New Executive Office Building, Room 10202, 725 17th Street, NW, Washington, DC 20503, Attention: Nicholas A. Fraser, the Desk Officer for the United States Patent and Trademark Office; and (2) by mail to Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, attention

Cynthia C. Lynch; by hand delivery to the Trademark Assistance Center, Concourse Level, James Madison Building-East Wing, 600 Dulany Street, Alexandria, Virginia, attention Cynthia C. Lynch; or by electronic mail message via the Federal eRulemaking Portal. All comments submitted directly to the Office or provided on the Federal eRulemaking Portal should include the docket number (PTO–T–2013-0026).

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects

37 CFR Part 2

Administrative practice and procedure, Trademarks.

37 CFR Part 6

Administrative practice and procedure, Classification, Trademarks.

37 CFR Part 7

Administrative practice and procedure, International registration, Trademarks.

For the reasons given in the preamble and under the authority contained in 15 U.S.C. 1123 and 35 U.S.C. 2, as amended, the Office proposes to amend parts 2, 6, and 7 of title 37 as follows:

PART 2 - RULES OF PRACTICE IN TRADEMARK CASES

1. The authority citation for 37 CFR Part 2 continues to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

2. Revise § 2.17(d)(1) to read as follows:

§ 2.17 Recognition for representation.

* * * * *

(d) * * *

(1) The owner of an application or registration may appoint a practitioner(s) qualified to practice under § 11.14 of this chapter to represent the owner for all existing applications or registrations that have the identical owner name and attorney through TEAS.

* * * * *

3. Revise § 2.19(b) introductory text to read as follows:

§ 2.19 Revocation or withdrawal of attorney.

* * * * *

(b) Withdrawal of attorney. If the requirements of § 11.116 of this chapter are met, a practitioner authorized to represent an applicant, registrant, or party to a proceeding in a trademark case may withdraw upon application to and approval by the Director or, when applicable, upon motion granted by the Trademark Trial and Appeal

Board. The practitioner should file the request to withdraw soon after the practitioner notifies the client of his/her intent to withdraw. The request must include the following:

* * * * *

4. Revise § 2.22(a)(19) to read as follows:

§ 2.22 Filing requirements for a TEAS Plus application

(a) * * *

(19) If the applicant owns one or more registrations for the same mark, and the owner(s) last listed in Office records of the prior registration(s) for the same mark differs from the owner(s) listed in the application, a claim of ownership of the registration(s) identified by the registration number(s), pursuant to § 2.36; and

* * * * *

5. Revise § 2.36 to read as follows:

§ 2.36 Identification of prior registrations.

Prior registrations of the same or similar marks owned by the applicant should be identified in the application if the owner(s) last listed in Office records of the prior registrations differs from the owner(s) listed in the application.

6. Amend § 2.38 by revising paragraph (b) to read as follows, and removing paragraph (c):

§ 2.38 Use by predecessor or by related companies.

* * * * *

(b) The Office may require such details concerning the nature of the relationship and such proofs as may be necessary and appropriate for the purpose of showing that the use by related companies inures to the benefit of the applicant and does not affect the validity of the mark.

7. Amend § 2.62 by adding new paragraph (c), to read as follows:

§ 2.62 Procedure for filing response.

* * * * *

(c) Form. Responses must be filed through TEAS, transmitted by facsimile, mailed or delivered by hand, as set out in § 2.190(a). Responses sent via e-mail will not be accorded a date of receipt.

8. Revise § 2.63 to read as follows:

§ 2.63 Action after response.

(a) Repeated non-final refusal or requirement. After response by the applicant, the examining attorney will review all statutory refusals and/or requirement(s) in light of the response.

(1) If, after review of the applicant's response, the examining attorney issues a non-final action that maintains any previously issued substantive refusal(s) to register or repeats any requirement(s), the applicant may submit a timely response to the action.

(2) If, after review of the applicant's response, the examining attorney issues a non-final action that contains no substantive refusals to register, but maintains any requirement(s), the applicant may respond to such repeated requirement(s) by filing a timely petition to the Director for relief from the repeated requirement(s) if the subject matter of the repeated requirement(s) is appropriate for petition to the Director (see § 2.146(b)). If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement(s) or thirty days from the date of the decision on the petition, whichever date is later, to comply with the repeated requirement(s). A requirement which is the subject of a petition decided by the Director subsequently may not be the subject of an appeal to the Trademark Trial and Appeal Board.

(b) Final refusal or requirement. Upon review of a response or request for reconsideration, the examining attorney may state that the refusal(s) to register, or the requirement(s), is final.

(1) If the examining attorney issues a final action that maintains any substantive refusal(s) to register, the applicant may respond by filing a timely appeal to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142.

(2) If the examining attorney issues a final action that contains no substantive refusals to register, but maintains any requirement(s), the applicant may respond by

filing: (i) a timely appeal of the requirement(s) to the Trademark Trial and Appeal Board under §§ 2.141 and 2.142; or (ii) a timely petition to the Director under § 2.146 to review the requirement(s), if the subject matter of the requirement(s) is procedural, and therefore appropriate for petition.

(3) Prior to the expiration of the time for filing an appeal or a petition, the applicant may file a request for reconsideration of the final action. The request must be signed by the applicant, someone with legal authority to bind the applicant, or a practitioner qualified to practice under § 11.14, in accordance with the requirements of § 2.193(e)(2). Filing a request for reconsideration does not stay or extend the time for filing an appeal or petition.

(4) Filing a request for reconsideration that does not result in the withdrawal of all refusals and requirements, without the filing of a timely appeal or petition, will result in abandonment of the application for incomplete response, pursuant to § 2.65(a).

(c) If a petition to the Director under § 2.146 is denied, the applicant will have until six months from the date of issuance of the Office action that repeated the requirement(s), or made it final, or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement(s). A requirement that is the subject of a petition decided by the Director subsequently may not be the subject of an appeal to the Trademark Trial and Appeal Board.

(d) If an applicant in an application under section 1(b) of the Act files an amendment to allege use under § 2.76 during the six-month response period after

issuance of a final action, the examining attorney will examine the amendment. The filing of such an amendment does not stay or extend the time for filing an appeal or petition.

§ 2.64 [Removed and Reserved]

9. Remove and reserve § 2.64.

10. Revise § 2.65 to read as follows:

§ 2.65 Abandonment.

(a) An application will be abandoned if an applicant fails to respond to an Office action, or to respond completely, within six months from the date of issuance. A timely petition to the Director pursuant to §§ 2.63(a) and (b) and 2.146 or notice of appeal to the Trademark Trial and Appeal Board pursuant to § 2.142, if appropriate, is a response that avoids abandonment.

(1) If all refusals and/or requirements are expressly limited to certain goods and/or services, the application will be abandoned only as to those goods and/or services.

(2) When a timely response by the applicant is a bona fide attempt to advance the examination of the application and is a substantially complete response to the examining attorney's action, but consideration of some matter or compliance with a requirement has been omitted, the applicant may be granted thirty days, or to the end of the response period set forth in the action to which the substantially complete

response was submitted, whichever is longer, to explain and supply the omission before considering the question of abandonment.

(b) An application will be abandoned if an applicant expressly abandons the application pursuant to § 2.68.

(c) An application will be abandoned if an applicant in an application under section 1(b) of the Act fails to timely file either a statement of use under § 2.88 or a request for an extension of time for filing a statement of use under § 2.89.

11. Revise § 2.68 to read as follows:

§ 2.68 Express abandonment (withdrawal) of application.

(a) Written document required. An applicant may expressly abandon an application by filing a written request for abandonment or withdrawal of the application, signed by the applicant, someone with legal authority to bind the applicant (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter, in accordance with the requirements of § 2.193(e)(2). A request for abandonment or withdrawal may not subsequently be withdrawn.

(b) Rights in the mark not affected. Except as provided in § 2.135, the fact that an application has been expressly abandoned shall not affect any rights that the applicant may have in the mark set forth in the abandoned application in any proceeding before the Office.

12. Revise § 2.77(b) to read as follows:

§ 2.77 Amendments between notice of allowance and statement of use.

* * * * *

(b) Other amendments may be entered during this period only with the express permission of the Director, after consideration on petition under § 2.146. If the Director determines that the amendment requires review by the examining attorney, the petition will be denied and the amendment may be resubmitted with the statement of use in order for the applicant to preserve its right for review.

13. Revise § 2.81(b) to read as follows:

§ 2.81 Post publication.

* * * * *

(b) In an application under section 1(b) of the Act for which no amendment to allege use under § 2.76 has been submitted and accepted, if no opposition is filed within the time permitted or all oppositions filed are dismissed, and if no interference is declared, a notice of allowance will issue. Thereafter, the applicant must submit a statement of use as provided in § 2.88.

14. Revise § 2.84(b) to read as follows:

§ 2.84 Jurisdiction over published applications.

* * * * *

(b) After publication, but before the certificate of registration is issued in an application under section 1(a), 44, or 66(a) of the Act, or before the notice of allowance is issued in an application under section 1(b) of the Act, an application that is not the subject of an inter partes proceeding before the Trademark Trial and Appeal Board may be amended if the amendment meets the requirements of §§ 2.71, 2.72 and 2.74. Otherwise, an amendment to such an application may be submitted only upon petition to the Director to restore jurisdiction over the application to the examining attorney for consideration of the amendment and further examination. The amendment of an application that is the subject of an inter partes proceeding before the Trademark Trial and Appeal Board is governed by § 2.133.

15. Revise § 2.142(f)(3) and (6) to read as follows:

§ 2.142 Time and manner of ex parte appeals.

* * * * *

(f) * * *

(3) If the further examination does result in an additional ground for refusal of registration, the examiner and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. If the ground for refusal is made final, the examiner shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the

additional ground for the refusal of registration. If the supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.

* * * * *

(6) If, during an appeal from a refusal of registration, it appears to the examiner that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examiner may, by written request, ask the Board to suspend the appeal and to remand the application to the examiner for further examination. If the request is granted, the examiner and appellant shall proceed as provided by §§ 2.61, 2.62, and 2.63. After the additional ground for refusal of registration has been withdrawn or made final, the examiner shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.

* * * * *

16. Revise § 2.145(a) to read as follows:

§ 2.145 Appeal to court and civil action.

(a) Appeal to U.S. Court of Appeals for the Federal Circuit. An applicant for registration, or any party to an interference, opposition, or cancellation proceeding, or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board, and any registrant who has filed an affidavit or declaration under section 8 or section 71 of the Act or who has filed an application for renewal and is

dissatisfied with the decision of the Director (§§ 2.165, 2.184), may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal:

* * * * *

17. Revise § 2.146(a)(1) and (g) to read as follows:

§ 2.146 Petitions to the Director.

(a) * * *

(1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by § 2.63(a) and (b);

* * * * *

(g) The mere filing of a petition to the Director will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§ 2.63(a) and (b) and 2.65 are applicable to an ex parte application.

* * * * *

18. Revise § 2.172 to read as follows:

§ 2.172 Surrender for cancellation.

Upon application by the owner, the Director may permit any registration to be surrendered for cancellation. The application for surrender must be signed by the owner of the registration, someone with legal authority to bind the owner (e.g., a corporate officer or general partner of a partnership), or a practitioner qualified to practice under § 11.14 of this chapter. When a registration has more than one class, one or more entire class(es) but fewer than the total number of classes may be surrendered. Deletion of fewer than all the goods or services in a single class constitutes amendment of the registration as to that class (see § 2.173), rather than surrender. A surrender for cancellation may not subsequently be withdrawn.

19. Revise § 2.185(a) to read as follows:

§ 2.185 Correcting deficiencies in renewal application.

(a) If the renewal application is filed within the time periods set forth in section 9(a) of the Act, deficiencies may be corrected after notification from the Office, as follows:

* * * * *

20. Amend § 2.198(a)(1) by revising paragraphs (a)(1)(vi) and (a)(1)(vii), and adding new paragraph (a)(1)(viii), to read as follows:

§ 2.198 Filing of correspondence by “Express Mail.”

(a)(1) * * *

(vi) Renewal requests under section 9 of the Act;

(vii) Requests to change or correct addresses; and

(viii) Affidavits of use under section 71 of the Act.

* * * * *

**PART 6 -- CLASSIFICATION OF GOODS AND SERVICES UNDER THE
TRADEMARK ACT**

21. The authority citation for 37 CFR Part 6 continues to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

22. Revise § 6.1, paragraph 5., to read as follows:

§ 6.1 International schedule of classes of goods and services.

* * * * *

5. Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for

dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.

* * * * *

**PART 7 – RULES OF PRACTICE IN FILINGS PURSUANT TO THE
PROTOCOL RELATING TO THE MADRID AGREEMENT CONCERNING
THE INTERNATIONAL REGISTRATION OF MARKS**

23. The authority citation for 37 CFR Part 7 continues to read as follows:

Authority: 15 U.S.C. 1123, 35 U.S.C. 2, unless otherwise noted.

24. Revise § 7.11(a)(3)(ii) to read as follows:

§ 7.11 Requirements for international application originating from the United States.

(a) * * *

(3) * * *

(ii) If the mark in the basic application or registration is depicted in black-and-white and includes a color claim, an international application filed on paper must include both a black-and-white reproduction of the mark and a color reproduction of the mark, and an international application filed electronically must include a color reproduction of the mark.

* * * * *

25. Revise § 7.23(a)(5) and (6) to read as follows:

§ 7.23 Requests for recording assignments at the International Bureau.

* * * * *

(a) * * *

(5) A statement that, after a good faith effort, the assignee could not obtain the assignor's signature for the request to record the assignment, signed and verified (sworn to) or supported by a declaration under § 2.20 of this chapter;

(6) An indication that the assignment applies to the designation to the United States or an international registration that is based on a U.S. application or registration;

* * * * *

26. Revise § 7.24(b)(5)(ii) and (b)(7) to read as follows:

§ 7.24 Requests to record security interest or other restriction of holder's rights of disposal or release of such restriction submitted through the Office.

* * * * *

(b) * * *

(5) * * *

(ii) Where the restriction is the result of an agreement between the holder of the international registration and the party restricting the holder's right of disposal, a

statement that after a good faith effort, the signature of the holder of the international registration could not be obtained for the request to record the restriction, or release of the restriction, signed and verified (sworn to) or supported by a declaration under § 2.20 of this chapter;

* * * * *

(7) An indication that the restriction, or the release of the restriction, of the holder's right of disposal of the international registration applies to the designation to the United States or an international registration that is based on a U.S. application or registration; and

* * * * *

27. Revise § 7.25(a) to read as follows:

§ 7.25 Sections of part 2 applicable to extension of protection.

(a) Except for §§ 2.21 - 2.23, 2.76, 2.88, 2.89, 2.130 - 2.131, 2.160 - 2.166, 2.168, 2.173, 2.175, 2.181 - 2.186 and 2.197, all sections in part 2 and all sections in part 11 of this chapter shall apply to an extension of protection of an international registration to the United States, including sections related to proceedings before the Trademark Trial and Appeal Board, unless otherwise stated.

* * * * *

28. Amend § 7.31 by revising the introductory text and paragraphs (a)(3) and (a)(4), and adding new paragraph (a)(5) to read as follows:

§ 7.31 Requirements for transformation of an extension of protection to the United States into a U.S. application.

If the International Bureau cancels an international registration in whole or in part, under Article 6(4) of the Madrid Protocol, the holder of that international registration may file a request to transform the goods and/or services to which the cancellation applies in the corresponding pending or registered extension of protection to the United States into an application under section 1 or 44 of the Act.

(a) * * *

(3) Identify the goods and/or services to be transformed, if other than all the goods and/or services that have been cancelled;

(4) The application filing fee for at least one class of goods or services required by § 2.6(a)(1) of this chapter; and

(5) An e-mail address for receipt of correspondence from the Office.

* * * * *

Date: January 15, 2014

Michelle K. Lee
Deputy Under Secretary of Commerce for
Intellectual Property and Deputy Director,
United States Patent and Trademark Office

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